REMARKS/ARGUMENTS

Claims 1-26 are pending in this patent application.

As a preliminary matter, Applicants thank the Examiner for acknowledging that the balance of the reply filed on July 31, 2003 has been entered and located in the file.

I. The Duggan Patent Is Not Prior Art in View of Applicants' Prior Invention

The Office is mistaken with respect to its assertion that Applicants' declarations under 37 CFR 1.131 are ineffective to overcome the prior art effect of the Duggan patent. Although the Office acknowledges that Applicants have demonstrated prior reduction to practice of certain species within the claimed genus the rejection over the Duggan patent nevertheless has been maintained because Applicants have not demonstrated prior reduction to practice of *all* species within the claimed genus. Specifically, the Office acknowledges that Applicants have demonstrated prior reduction to practice of apparatus comprising indicating means that are responsive to absorption and reflection of electromagnetic energy, but maintains the rejection because Applicants allegedly have not demonstrated prior invention with respect to apparatus comprising indicating means that are responsive to fluorescence of electromagnetic energy. (Advisory Action dated November 10, 2003, at 5)

Significantly, however, there is no requirement that Applicants demonstrate reduction to practice of each and every claimed species. MPEP 715.02, for example, states that, except in unpredictable arts, an applicant need only demonstrate reduction to practice of a single species:

> GENERAL RULE AS TO GENERIC CLAIMS
>
> A reference or activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 **showing completion of the invention of only a single species**, within the genus, prior to the effective date of the reference or activity (assuming, of course, that the reference or activity is not a statutory bar or a patent, or an application publication, claiming the same invention). ... See, however, MPEP § 715.03 for practice relative to cases in unpredictable arts.

(emphasis supplied, citations omitted). Since an applicant need only demonstrate reduction of a single claimed species – and since the Examiner has not indicated in any correspondence

to date that he is of the view that the art area to which the pending claims are directed is unpredictable – Applicants' demonstrated reduction to practice with respect to *multiple* species within the claimed genus is effective to antedate the Duggan patent. Accordingly, Applicants request that the 35 U.S.C. § 102 and 103 rejections based on the Duggan patent be withdrawn.

II. The Decision Granting Petition Largely Controls the Double Patenting Issues

The Decision Granting Petition mailed on October 12, 2001, in connection with both the instant patent application and parent application 09/187,579, now U.S. Patent No. 6,246,062, largely controls the filing of such terminal disclaimers and statutory disclaimers to address the pending double patenting issues in these cases. In this regard, Applicants respectfully submit that deferring the filing of such disclaimers at this time is certainly appropriate in view of the unusual circumstances of this case. For example, it is not yet timely for Applicants to file a terminal disclaimer over the parent patent to overcome the obviousness-type double patenting rejections of claims 25 and 26 if a statutory disclaimer is to be filed in the parent patent.

Accordingly, upon the Office's removal of the Duggan patent as prior art in view of the Rule 131 Newton declaration, Applicants will consider canceling claims 1-24 of the instant application and will consider filing a terminal disclaimer to U.S. Patent No. 6,246,062 to overcome the obviousness-type double patenting rejections of claims 25 and 26.

III. Conclusions

Applicants request the Examiner to withdraw the Duggan patent as prior art so that only the double patenting rejections of claims 1-26 remain pursuant to the Decision Granting Petition. In so doing, Applicants will then consider canceling claims 1-24 in the instant application to address the statutory double patenting rejections. Applicants will also consider filing a terminal disclaimer to U.S. Patent No. 6,246,062 to overcome the obviousness-type double patenting rejections of claims 25 and 26.

If the Examiner is of contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-5984.

Respectfully submitted,

Date: November 25, 2003

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